

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 19, 2004. Upon entry of the amendments in this response, claims 1 - 20 remain pending. Applicant has amended claims 1, 4, 11, and 16. The subject matter of claims 1, 4, 11, and 16 is supported at least with respect to Applicant's originally filed FIGs 1, 4, and 8 and the related detailed description. Accordingly, no new matter has been added to the application.

Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. In the Drawings

The Office Action indicates that the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference signs mentioned in the description. Specifically, the Office Action indicates that reference item 535 is not found in the drawings.

Applicant has submitted an amendment to the specification such that the specification conforms to the originally submitted drawings. Specifically, page 12, line 17, recites "actuating icon 635" in the detailed description related to FIG. 6. Reference item 635 appears near the lower left corner of Applicant's originally submitted FIG. 6. Thus, Applicant's drawings include the reference signs mentioned in the description and the objection to the drawings should be withdrawn.

II. Rejections Under 35 U.S.C. §102(b) – Claims 1 – 5, 7, and 11 - 20

A. Statement of the Rejection

The Office Action indicates that claims 1 – 5, 7, and 11 - 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Neuhard* (U.S. Patent 6,335,795).

B. Discussion of the Rejection

Applicant's independent claims 1 and 11, as amended, contain features that are not disclosed, taught, or suggested in *Neuhard*. Accordingly, claims 1, 11, and 16 are not anticipated by *Neuhard*. Because independent claims 1, 11, and 16 are not anticipated, dependent claims 2 – 5, 7, 12 - 15, and 17 - 20, which depend directly or indirectly from independent claims 1, 11, and 16 are also not anticipated by *Neuhard*.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See *e.g.*, *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988). *Neuhard* fails to disclose, teach, or suggest each element and/or method step in the claims.

1. **Claims 1 – 5, and 7**

Turning now to the specific claim rejections, claim 1 is exemplary. For convenience of analysis, independent claim 1, as amended, is repeated below in its entirety.

1. A method for facilitating network device capability utilization within a network, said method comprising the steps of:
 - enabling a user to select desired attributes of a network device for processing a job;
 - determining attributes of network devices communicating with the network via a direct communication with the network devices***; and
 - facilitating processing of the job at one of the network devices corresponding to the desired attributes selected by the user.

(Applicant's independent Claim 1 - *Emphasis added.*)

Applicant respectfully asserts that *Neuhard* fails to disclose, teach, or suggest at least the highlighted feature of independent claim 1. More specifically, *Neuhard* fails to disclose, teach, or suggest a method for facilitating network device capability utilization within a network that comprises "***determining attributes of network devices communicating with the network via a direct communication with the network devices.***" In this regard, *Neuhard* apparently discloses the selection of a specific printer from a print server. The functional block diagram illustrated in FIG. 1 of *Neuhard* indicates that printer 31 is coupled to data communication devices 16a – 16c and client computers 4a – 4c via a print server 6.

In contrast with *Neuhard*, Applicant's claimed method includes the feature that attributes of network devices are determined via a direct communication with the network devices. Accordingly, *Neuhard*, which apparently teaches coupling the printer via a print server, does not disclose, teach, or suggest "***determining attributes of network devices communicating with the network via a direct communication with the network devices.***" Thus, *Neuhard* fails to anticipate amended claim 1. Accordingly, the rejection of claim 1 should be withdrawn.

Because independent claim 1 is allowable, dependent claims 2 – 5 and 7, which depend either directly or indirectly from claim 1, are also allowable. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection of claims 1 –5 and 7 be withdrawn.

2. Claims 11 – 15

For convenience of analysis, independent claim 11, as amended, is repeated below in its entirety.

11. A computer readable medium having a computer program for facilitating network device capability utilization within a network, said computer readable medium comprising:

logic configured to enable a user to select desired attributes of a network device for processing a job;

logic configured to determine attributes of network devices communicating with the network by a direct communication with network devices; and

logic configured to facilitate processing of the job at one of the network devices corresponding to the desired attributes selected by the user.

(Applicant's independent Claim 11 - *Emphasis added*.)

Applicant respectfully asserts that *Neuhard* fails to disclose, teach, or suggest at least the highlighted feature of independent claim 11. More specifically, *Neuhard* fails to disclose, teach, or suggest a computer readable medium having a computer program for facilitating network device capability utilization within a network comprising “***logic configured to determine attributes of network devices communicating with the network by a direct communication with network devices.***” As shown above, *Neuhard* apparently discloses the selection of a specific printer from a print server. The functional block diagram illustrated in FIG. 1 of *Neuhard* indicates that printer 31 is coupled to data communication devices 16a – 16c and client computers 4a – 4c via a print server 6.

In contrast with *Neuhard*, Applicant's claimed computer-readable medium comprises logic configured to determine attributes of network devices by a direct communication with network devices. Accordingly, *Neuhard*, which apparently teaches coupling the printer via a print server, does not disclose, teach, or suggest “***logic configured to determine attributes of network devices communicating with the network by a direct communication with network***

devices.” Thus, *Neuhard* fails to anticipate amended claim 11. Accordingly, the rejection of claim 11 should be withdrawn.

Because independent claim 11 is allowable, dependent claims 12 – 15, which depend either directly or indirectly from claim 11, are also allowable. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection of claims 11 – 15 be withdrawn.

2. Claims 16 - 20

Claim 16 is also exemplary. For convenience of analysis, independent claim 16, as amended, is repeated below in its entirety.

16. A system for facilitating network device capability utilization within a network, said system comprising:
means for enabling a user to select desired attributes of a network device for processing a job;
means for determining attributes of network devices communicating with the network via a direct communication with network devices; and
means for facilitating processing of the job at one of the network devices corresponding to the desired attributes selected by the user.

(Applicant’s independent Claim 16 - *Emphasis added*.)

Applicant respectfully asserts that *Neuhard* fails to disclose, teach, or suggest at least the highlighted feature of independent claim 16. More specifically, *Neuhard* fails to disclose, teach, or suggest a system for facilitating network device capability utilization within a network comprising “***means for determining attributes of network devices communicating with the network via a direct communication with network devices***.” As shown above, *Neuhard* apparently discloses the selection of a specific printer from a print server. The functional block diagram illustrated in FIG. 1 of *Neuhard* indicates that printer 31 is coupled to data communication devices 16a – 16c and client computers 4a – 4c via a print server 6.

In contrast with *Neuhard*, Applicant’s claimed system comprises means for determining attributes of network devices via a direct communication with network devices. Accordingly, *Neuhard*, which apparently teaches coupling the printer via a print server, does not disclose, teach, or suggest Applicant’s claimed “***means for determining attributes of network devices communicating with the network via a direct communication with network***

devices.” Thus, *Neuhard* fails to anticipate amended claim 16. Accordingly, the rejection of claim 16 should be withdrawn.

Because independent claim 16 is allowable, dependent claims 17 – 20, which depend either directly or indirectly from claim 16, are also allowable. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection of claims 16 – 20 be withdrawn.

III. Rejections under 35 U.S.C. §103 – Claims 6 and 8 - 10

A. Statement of the Rejection

The Office Action indicates that claims 6 and 8 - 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Neuhard* in view of *Boldt* (U.S. Patent 6,349,304).

B. Discussion of the Rejection

The rejection of claims 6 and 8 - 10 is legally deficient because the *Boldt* reference cannot be used as a basis for a rejection under 35 U.S.C. §103 for at least the reason that *Boldt* appears to disclose non-analogous art. In order to rely on a reference, as a basis for supporting a rejection of an applicant’s systems and methods, the reference must be from analogous art. In other words, the reference must be either in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01(a); *See, In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993.).

The Applicant in the present application is concerned with determining the capabilities of available network coupled resources and making those capabilities available to an operator of a network coupled computing device to complete a task. For example, the preamble of claim 1 indicates that the method is for facilitating network device capability utilization within a network. Accordingly, the present application is concerned with efficient network resource utilization.

In contrast with the Applicant’s systems and methods, the *Boldt* reference is directed to a method for configuring devices as they are added to a network. Without going into unnecessary detail, Applicant notes that much of the disclosure of the *Boldt* reference involves a detailed description of copying configuration files of like devices found on a

network. The *Boldt* reference is entirely silent regarding network operation and efficient network resource utilization. Thus, Applicant submits that *Boldt* is improper “nonanalogous art” that may not be relied upon to support a rejection under §103. Accordingly, Applicant requests that for at least this reason the rejection be withdrawn and claims 6 and 8 - 10 be allowed.

The rejection of claims 6 and 8 - 10 is legally deficient because the rejection fails to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness by combining references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill, to modify the primary reference (*Neuhard*) in the manner allegedly taught by the secondary reference (*Boldt*). See e.g., MPEP §§2142, 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Even though Applicant believes the §103 rejection is improper because *Boldt* is unavailable “nonanalogous art,” Applicant further submits that the Office Action fails to establish a proper motivation or suggestion to modify the alleged teaching of *Neuhard* with the alleged teaching of *Boldt* such as to render obvious claims 6 and 8 - 10.

Specifically, with regards to claim 6, the Office Action alleges that *Neuhard* discloses all of the limitations of claim 4 (from which claim 6 depends) absent a web-based graphical user interface. The Office Action alleges that *Boldt* teaches the use of a web-based graphical user interface via a web browser. The Office Action then concludes that it would have been obvious to modify *Neuhard* to include a web browser to view the web-based user interface of *Boldt* to allow a user greater flexibility in accessing the program remotely from a centralized server on a variety of software applications. Applicant disagrees.

Concerning claim 8, the Office Action alleges that *Neuhard* discloses all of the limitations of claim 8 absent that the user interface is shown in a web browser. The Office Action alleges that *Boldt* teaches the use of a web-based graphical user interface via a web browser. The Office Action then concludes that it would have been obvious to modify *Neuhard* to include a web browser to view the web-based user interface of *Boldt* to allow a user greater flexibility in accessing the program remotely from a centralized server on a variety of software applications. Applicant disagrees.

It is well-established law that, in order to properly combine select elements from differing prior art sources, there must be some teaching or suggestion *within the prior art* to

make the combination specifically claimed by the Applicant's invention. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." ***Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure...*** In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added.) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

It has often been noted that, "[h]umans must work with old elements, most if not all of which will normally be found somewhere in an examination of the prior art." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 U.S.P.Q. 193 (Fed. Cir. 1983). Furthermore, that features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. It is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Id.*

Applicant respectfully submits that the purported motivation or suggestion provided by the Office Action is a classic example of impermissible hindsight reasoning based solely on the Applicant's disclosure. In this regard, the purported motivation cited in the Office Action ("to allow a user greater flexibility in accessing a program remotely on a centralized server on a variety of software applications") is NOT found in *Boldt*. The Office Action alleges that the suggestion or motivation to combine the references is found in column 10, lines 2 – 15 of *Boldt*. The cited paragraph from *Boldt*, however, specifically states "Once launched from within a Web browser, the logic of FIG. 8 can execute outside of the Web browser to perform other activities." This language does not suggest the motivation cited in the Office Action ("to allow a user greater flexibility in accessing a program remotely on a centralized server on a variety of software applications"). Applicant notes that this cited

language is the ONLY language, which is used to support the allegation of the motivation or suggestion to combine the references.

This cited language is legally insufficient to meet the Office's *prima facie* burden of establishing a proper motivation or suggestion to combine the references. In this regard, Applicant respectfully asserts that the cited language -- "once launched from within a Web browser, the logic of FIG. 8 can execute outside of the Web browser to perform other activities" -- does not suggest the desirability of combining *Neuhard* with *Boldt*. The objective of *Neuhard* is to create a method for customizing print attribute choices based on a selected model, media, and printer. *Boldt* has nothing to do with customizing print attribute choices. Rather, the objective of *Boldt* is to provide a method of copying configuration files to newly installed devices on a network. Furthermore, *Neuhard* and *Boldt* are silent regarding Applicant's motivation, which is to provide a method for facilitating network device capability utilization within a network. Thus, Applicant respectfully submits that the Office Action fails to establish a proper suggestion or motivation to combine *Neuhard* with *Boldt* in the manner suggested.

Applicant notes that the improper combination of *Neuhard* and *Boldt* is the basis for the rejection of claims 6 and 8 - 10. Accordingly, Applicant respectfully submits that the rejection of claims 6 and 8 - 10 is improper for at least this additional reason and therefore requests that the rejections be withdrawn.

Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 - 20 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



Robert A. Blaha, Reg. No. 43,502

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500